

Remarks

Applicant has amended Claims 1, 10, 12, and 14, cancelled Claims 9 and 11, and added a new Claim 30. Applicant respectfully submits that no new matter was added by the amendment, as all of the amended matter was either previously illustrated or described in the drawings, written specification and/or claims of the present application. In particular, support for this amendment is found in at least ¶¶ 41, 96 – 99, 101 – 104, and 114 of Applicant's Specification and Figures 2a, 2b, and 7. Entry of the amendment and favorable consideration thereof is earnestly requested.

Allowable Subject Matter

The Examiner has indicated that Claim 14 would be allowable if rewritten in independent form. Applicant has therefore added a new Claim 30 which represents Claim 14 rewritten in independent form.

Claim Rejections – 35 USC § 102

The Examiner has rejected Claims 1, 13, 28 and 29 under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 4,919,114 to Miyazaki ("the Miyazaki patent"). The Examiner has further rejected Claims 1, 13, 28 and 29 under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 5,916,148 to Tsuyuki ("the Tsuyuki '148 patent"). These rejections are respectfully traversed.

Claim 1 has been amended to include the limitations of Claims 9 and 11, and the further limitations that the interchangeable head is connected to the distal end of the shaft at the coupling points by means of at least two positioning pins that engage in corresponding bores, and wherein the at least two positioning pins are exchangeable.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verde-gaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Applicant respectfully submits that the above limitations are not found in either the Miyazaki patent or the Tsuyuki '148 patent. As such, Claim 1 and each of the claims depending therefrom cannot be anticipated by the Miyazaki patent or the Tsuyuki '148 patent.

Claim Rejections – 35 USC § 103

The Examiner has further rejected Claims 1, 9 – 12, 15, 16, 28 and 29 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 5,547,457 to ("the Tsuyuki '457 patent") in view of U.S. Patent No. 5,279,756 to Pileski et al. ("the Pileski patent").

In the present and the previous Office Action, the Examiner referred to the Tsuyuki '457 patent with respect to the feature of the connection of an interchangeable head to the distal end of a shaft by means of a positioning pin. The Examiner has indicated that the wire "WM" in Fig. 2 of the Tsuyuki '457 patent is a positioning pin for connecting the exchangeable head AD with the distal end of the shaft M. However, the wire WM is not a positioning pin, but is instead a mechanical control wire forming part of the deviating mechanism for the distal end of the endoscope shaft, as can be seen in Fig. 2 and described in Col. 2, lines 26 – 38.

Applicant also respectfully disagrees with the Examiner's assertion that the wire WM of the Tsuyuki '457 patent anticipates a positioning pin that serves the purpose of transmitting electric signals or electric power as required by Claim 12. However, the wire WM is merely a control wire for mechanically controlling the deviating of the distal end of the shaft and does not transmit any electric signals or power. See, e.g., Col. 2, lines 43 – 58 of the Tsuyuki '457 patent that describes the wire WM having an engaging

end E extending to a manual controller and another end with a rack R which engages with a pinion PI fixed to a control knob. “[T]he control knob is turned to move the rack R, thereby moving the movable frame back and forth by way of the wire WM.” Col. 2, lines 56 – 58.

There is also no disclosure in the Tsuyuki '457 patent of “at least two positioning pins that engage in corresponding bores” for connecting “said interchangeable head” “to said distal end of said shaft at said coupling point” as required by all pending claims. Even if the wire WM were considered to be a positioning pin, which the Applicant disputes, there is only one wire WM. The use of at least two positioning pins for connecting the interchangeable head with the distal end of the shaft has the advantage that the interchangeable head is rotationally fixed to the endoscope shaft with substantially no play in the circumferential direction. Further, in the Tsuyuki '457 patent the wire WM is not disclosed to be exchangeable, while Claim 1 as amended requires that the at least two positioning pins are exchangeable. The exchangeability is an advantageous feature, because the small pins may be subject to bending or breaking due to improper handling and may require an exchange.

The Pileski patent fails to provide the teachings missing from the Tsuyuki '457 patent. In the previous Office Action, the Examiner also referred to U.S. Patent No. 6,184,923 to Miyazaki et al. (“the Miyazaki '923 patent”) as disclosing the positioning pin of Applicant's claims. However, even if the location pin 35 of the Miyazaki '923 patent corresponded to a positioning pin, only one location pin 35 is disclosed and the location pin 35 is also not exchangeable as required by Applicant's Claim 1. Therefore Claim 1, and each of the claims depending therefrom, cannot be obvious in view of the cited prior art.

It is respectfully submitted that claims 1, 6, 10, 12 – 16, and 28 – 30, all of the claims remaining in the application, are in order for allowance and early notice to that effect is respectfully requested.

Respectfully submitted,

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